

REMARKS

Applicant has carefully studied the Final Office Action of April 26, 2005, and offers the following remarks to accompany the above amendments.

Claim 47 is amended to correct an article in the preamble. No new matter is added.

Applicant initially notes that the Response filed February 11, 2005 did not include status identifiers for each claim. Applicant herein presents all the pending claims along with the appropriate status identifiers. Applicant apologizes for this oversight.

Before addressing the rejections, Applicant provides a brief summary of the invention so that the remarks and amendments are considered in the proper context. The present invention is designed to provide location based content to mobile terminal users wherein the location based content corresponds to the current location of the mobile terminal. There are two embodiments through which the location based content can be provided. In the first embodiment, the content provision is service-centric. That is, a service that resides in the mobile network associates unique URLs with different content providers, and the service further associates location specific information with each URL. The service-centric embodiment is based on a push model where the location specific URLs for location specific content are automatically provided to the user's mobile terminal based on the mobile terminal's location. The specific URLs are closely tied to the specific location of the mobile terminal. By providing the mobile terminal with the specific URL corresponding to the current location of the mobile terminal, the present invention allows the user of the mobile terminal to access very specific content tailored to the current location of the user of the mobile terminal. To put this in the terms of the examples used in the specification: if a person stepped off a bus in San Francisco, California, she would have the URL for the San Francisco citysearch (www.bayareacitysearch.com) on her mobile terminal.

The second embodiment is a user-centric embodiment. In this embodiment, the user dictates the services to which she subscribes and when addresses or URLs are provided to the user. By providing the mobile terminal with the specific address corresponding to the specific location of the mobile terminal, the present invention allows the user of the mobile terminal to access very specific content tailored to the current location of the mobile terminal. Using the example of the specification, a user would subscribe to the citysearch service, and upon activating a trigger, would receive the URL for the local citysearch webpage based on the current

location of the mobile terminal (e.g. www.bayareacitysearch.com). From the received URL, the user could access location specific content.

Claims 39 and 47 were rejected under 35 U.S.C. § 112, second paragraph for being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses. Applicant notes that 35 U.S.C. § 112, second paragraph has two separate requirements. The first requirement is that the claims must set forth the subject matter that Applicant regards as the invention. The second requirement is that the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent. MPEP § 2171.

The text used to set forth the rejection under 35 U.S.C. § 112, second paragraph is not clear whether the rejection is based on the first or second requirement. Specifically, the first part of the rejection seems to indicate that the second requirement is at issue, but the conclusion of the sentence seems to indicate that the first requirement is at issue. Regardless, Applicant satisfies both requirements as explained below.

The first requirement that Applicant claim the subject matter that Applicant regards as the invention is a subjective requirement. A rejection based on this requirement is only appropriate when Applicant has stated, somewhere other than the application as filed, that the invention is something different than what is defined by the claims. MPEP § 2172. As Applicant has only filed one response, which included the new claims directed to the subject matter in question, along with remarks about the patentability of those new claims, there is no evidence in the record that Applicant believes something other than the currently pending claims to be the invention. If the Patent Office disagrees, the Patent Office is requested to identify with particularity what evidence suggests that Applicant regards something else as the invention. MPEP § 2172(II). If the Patent Office was using the first requirement as the basis for the 35 U.S.C. § 112, second paragraph, Applicant respectfully submits that this is in error, and requests that this rejection be withdrawn.

The second requirement that the claims must particularly point out and distinctly claim the invention is less subjective. The purpose of this requirement is to ensure that the scope of the claims is clear. The focus is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. All that is required is a reasonable degree of particularity and distinctness. "Some latitude in the manner of

expression and the aptness of term should be permitted even though the claim language is not as precise as the examiner might desire.” MPEP § 2173.02. Definiteness of claim language must be analyzed, not in a vacuum, but in light of: the content of the particular application disclosure; the teachings of the prior art; and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *Id.*

The Patent Office’s first issue is that a person of ordinary skill in the art would not be able to ascertain what makes said content unique and location specific, and provides a number of alternative situations where the content might be construed to be non-unique. Applicant uses the term “unique” throughout the specification. While Applicant appreciates that limitations of the specification are not imported into the claims, as noted above, the definiteness and clarity of a term is not considered in a vacuum, but is considered in light of Applicant’s disclosure in the application. When someone of ordinary skill in the art reads Applicant’s disclosure, she sees several examples of what is intended by “unique content”, especially since that term is contrasted from the concept of “common content”. Still further explanation of the term “unique content” can be found in the specification, paragraph 0027, which Applicant believes fully addresses the concerns of the Patent Office about the differing host devices. The further example of citysearch.com in paragraph 0003 of the specification also provides a clear indication to someone of ordinary skill in the art what is intended by “unique content”. The citysearch.com example also helps address the Patent Office’s concerns about the location specific content. In short, while the Patent Office may feel that there are better terms that are more clear than the terms used in the claims, the language used in the pending claims does not make the claims so imprecise as to support a rejection under 35 U.S.C. § 112, second paragraph. Therefore, Applicant requests withdrawal of the rejection at this time.

The Patent Office concludes its rejection with the statement: “it is unclear whether the location specific unique content is referring to the location of the mobile user or location of the host device”. Applicant respectfully traverses. The preambles of the claims provide the context needed to understand the location at issue. Specifically, the preamble of claim 39 recites a “method for providing content to a mobile terminal user based on a location of a mobile terminal. . . .” This preamble makes it clear that the location specific unique content is referring to the location of the mobile user. The preamble of claim 47 is substantially identical, albeit as

an apparatus claim rather than a method claim. In light of this explanation, Applicant requests withdrawal of the § 112 rejection at this time.

If the Patent Office decides to maintain the § 112 rejection, Applicant requests that the Examiner contact the undersigned by telephone so that this issue may be discussed further. However, based on the text of the Office Action, the § 112 rejection appears unfounded.

Claims 39-43, 46-51, and 54 were rejected under 35 U.S.C. § 103 as being unpatentable over Owensby in view of Heddaya et al. (hereinafter "Heddaya"). Applicant respectfully traverses. For the Patent Office to combine references in an obviousness analysis, the Patent Office must do two things. First, the Patent Office must articulate a motivation that suggests the combination of references, and second, the Patent Office must support the articulated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Furthermore, if a combination of references renders a reference unsuitable for its intended purpose, the combination is non-obvious. MPEP § 2143.01. Even if the combination is properly made, to establish *prima facie* obviousness, the combination must still teach or suggest all the claim elements. MPEP § 2143.03.

Applicant initially traverses the rejection because the Patent Office's motivation does not compel the nature of the combination proposed by the Patent Office. Specifically, the Patent Office opines that the motivation to combine Owensby and Heddaya is "to distribute the servicing of requests across multiple intermediate or secondary servers, such server being closer to the requesting user (by number of hops and distance), such that response time is faster and less network traffic is created. (See Heddaya, Column s [sic] 4 Lines 1-10)" (Office Action of April 26, 2005, page 7, lines 8-11). However, the Patent Office opines that the use of Heddaya's intermediate servers results in "content that may be customized and be made unique according to the location of the intermediate node." (Office Action of April 26, 2005, page 7, lines 6-7). The combination does not compel this customization. Rather the combination results in intermediate nodes that pass the common content of Heddaya to the client from the server. The Patent Office has provided no evidence that the combination would result in the customization of the content at the intermediate node. To this extent, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejections based on the combination are improper, and all the pending claims are allowable. Applicant requests withdrawal of the § 103 rejections on this basis.

Applicant further traverses the combination as non-obvious because the combination renders Heddaya unsuitable for its intended purpose. That is, assuming that the Patent Office is correct (a point Applicant does not concede) about how the references combine, and that the content is customized according to the location of the intermediate node, this change in the content vitiates Heddaya's purpose of providing proxy intermediate nodes that spoof the clients into believing that the proxy is the desired server (see Heddaya, col. 4, lines 10-15). The particular example that becomes non-functional is the news server described at Heddaya, col. 10, line 48-col. 11, line 29. That is, once the content diverges between the various nodes, the mobile agent of Heddaya no longer knows how to intercept messages and reroute requests to the closest server. Since the proposed combination renders Heddaya unsatisfactory for its intended purpose, the combination is non-obvious. MPEP § 2143.01. Since the combination is non-obvious, the rejections based on the combination are improper. Since the rejections based on the combination are improper, all the pending claims are allowable. Applicant requests withdrawal of the § 103 rejections based on the combination of Owensby and Heddaya on this basis as well.

Applicant still further traverses the rejections based on Owensby and Heddaya for failing to establish *prima facie* obviousness. Claim 39 recites "... establishing a plurality of unique internet protocol addresses from each of which unique content may be accessed. . . ." Claim 47 recites an analogous element. The Patent Office does not specifically identify where this element is taught in the references, but the closest citation in the Office Action is Owensby, col. 11, lines 60-65, col. 22, lines 35-65, and col. 23, lines 1-25. (Office Action of April 26, 2005, p. 4, lines 2-5). Applicant respectfully traverses the assertion that these passages teach the recited claim element.

Owensby, col. 11, lines 60-65 states in full: "...transceiver (not shown) for transmitting and receiving audio, video and/or electronic data in conjunction with conventional wireless communications services, such as wireless mobile telephony service, wireless mobile data transmission service and wireless mobile global computer network (e.g., Internet®) service. Most preferably, the wireless communications" While the passage does indicate that a transceiver works with the Internet, there is no indication that a plurality of unique internet protocol addresses are established from each of which unique content may be accessed, as recited in the claim. Merely because the passage uses the word "internet" does not mean that the

passage teaches or suggests the recited establishing of a plurality of unique internet protocol addresses from each of which unique content may be accessed.

Owensby, col. 22, lines 35-65 states in full:

The Call Record Generator 29 also forwards the Ad Insert Records data to the Subscriber Support Module, indicated at 31 in FIG. 3. The Subscriber Support Module 31 processes inquiries, responses and requests from the subscriber. Immediately following completion of a targeted advertisement, a group of targeted advertisements or a call which included a targeted advertisement of particular interest to the subscriber, the Subscriber Support Module 31 can insert a related advertisement to provide additional information to the subscriber. The inquiry, response or request from the subscriber may be received and answered by a subscriber support representative or may be transmitted to the Subscriber Support Module 31 for processing by a keypad or voice command from the subscriber. The information provided to the subscriber may vary based on the geographical location of the subscriber at the time that the inquiry, response or request is made. Alternately, customer inquiries, responses and requests from the subscriber may be addressed externally by a subscriber support representative using information provided to the representative by the Subscriber Support Module 31. The Subscriber Support Module 31 may also be programmed to forward the call to an external destination, such as a telemarketing representative. Additional information or forwarded calls may occur during the call immediately upon request, immediately after the call is completed or by a programmed call back. In addition, the Subscriber Support Module 31 may have the ability to provide information relating to the targeted advertisements previously provided to the subscriber. For example, when called by a subscriber, the Subscriber Support Module 31 may have the ability to provide the subscriber. . . .

The cited passage makes no reference to establishing internet protocol addresses from each of which unique content may be accessed. Rather, the passage references the advertisements that may be provided to the subscriber. There is, quite simply, no addressing scheme in this passage that could be equated to the recited element. As such, this passage does not teach or suggest the claim element.

Owensby, col. 23, lines 1-25 states in full:

. . . when each advertisement was inserted, the geographical location of the subscriber at the time the advertisement was inserted, the amount of the subsidy earned by the subscriber for the targeted advertisement, a contact number for the sponsor of the advertisement and any additional which the subscriber support representative can provide to the subscriber.

The Call Record Generator 29 may also be programmed to generate various reports for use by the operator of the service for subscriber billing and for progress and effectiveness review by the operator of the service or the sponsor of the

advertisement. The Call Record Reports may list information such as the amount of subsidy earned by the subscriber, the geographical location for which an advertisement was inserted, the date and time at the location for which the advertisement was inserted, the order in which the advertisement was inserted in the call, an indication of whether the advertisement was fully inserted or partially inserted, the entire Subscriber Profile Data of the subscriber for whom the advertisement was inserted (possibly including address, name and home telephone number), whether the advertisement was a perfect match or involved a lower hierarchy match, the charge credit against the subscriber's account and the balance of the subscriber's account on the report date.

This passage, like the passage above, says nothing about any sort of addressing scheme or establishing a plurality of unique internet protocol addresses from each of which unique content may be accessed. As such, the cited passage does not teach or suggest the claim element.

Since none of the cited passages teach or suggest the claim element, the combination of Owensby and Heddaya do not teach or suggest the claim element. At a minimum, the Patent Office has not shown where in the combination the claim element is taught or suggested. Since it is the Patent Office's burden to establish *prima facie* obviousness, and the Patent Office has not satisfied this burden, the obviousness rejections of the claims are improper. If the Patent Office disagrees, Applicant requests that the Patent Office explain with greater particularity where in these cited passages a plurality of internet protocol addresses from each of which unique content may be accessed are established. In the absence of such an identification, Applicant requests withdrawal of the § 103 rejections on this basis.

Applicant still further traverses the Patent Office's assertion that Owensby teaches "associating each of the plurality of unique internet protocol addresses with different geographic locations. . ." as recited in claim 39 (again, claim 47 also has a directly analogous element). The Patent Office relies on the portions of Owensby quoted above (Office Action of April 26, 2004, p. 4). Owensby, col. 11, lines 60-65 does indicate that a transceiver works with the internet, but there is no associating of unique addresses within the internet with different geographic locations. Thus, the first passage does not teach or suggest the claim element. Owensby, col. 22, lines 35-65 does state "information provided to the subscriber may vary based on the geographical location of the subscriber at the time that the inquiry, response or request is made." (Owensby, col. 22, lines 48-52). However, there is no association of each of the unique internet protocol addresses with different geographic locations as recited in the claim. Merely because the passage states that information may vary based on the location of the subscriber does not

mean that the passage teaches or suggests that internet protocol addresses are associated with different geographic locations. Indeed, there is no indication that the information of the passage is associated with any internet protocol address. Rather, the information is inserted into the call, but the passage is silent as to the storage mechanism that contains the information, or how the information is accessed such that it is inserted into the call. Thus, this passage does not teach the recited claim element.

Owensby, col. 23, lines 1-25 also describes that the call record may track "the geographical location of the subscriber at the time the advertisement was inserted" (Owensby, col. 23, lines 1-3 and 13-16), but the passage is again silent as to how the advertisement is located or tracked. Specifically, there is no teaching or suggestion in the passage that internet protocol addresses are associated with different geographic locations as recited in the claims.

Since none of the cited passages teach or suggest the claim element, the combination of Owensby and Heddaya do not teach or suggest the claim element. At a minimum, the Patent Office has not shown where in the combination the claim element is taught or suggested. Since it is the Patent Office's burden to establish *prima facie* obviousness, and the Patent Office has not satisfied this burden, the obviousness rejections of the claims are improper. If the Patent Office disagrees, Applicant requests that the Patent Office explain with greater particularity where in these cited passages a plurality of internet protocol addresses from each of which unique content may be accessed are established. In the absence of such an identification, Applicant requests withdrawal of the § 103 rejections on this basis.

Applicant still further traverses the Patent Office's assertion that "while Owensby does not explicitly state providing internet protocol addresses it is obvious that in providing service provider contact information to the user, a form of internet addressing would be required in order to connect the user to the global computer network (the Internet service)." (Office Action of April 26, 2005, p. 4, lines 11-14). Initially, Applicant sees no evidence that teaches or suggests that Owensby teaches providing service provider contact information. While Owensby does allow the subscriber to establish a direct communication with a representative, there is no address provided to the subscriber. (See Owensby, col. 10, lines 1-10). Even if the ability to establish a connection to a representative implies some form of address is provided, this address is not associated with any sort of location within the teachings of Owensby. Thus, the Patent Office's assertion that this internet protocol address is obvious is incorrect.

Applicant notes that for the Patent Office to modify a reference in an obviousness rejection, the Patent Office must do two things. First, the Patent Office must articulate a motivation to modify the reference, and second, the Patent Office must support the articulated motivation to modify with actual evidence. *In re Kozab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). If the Patent Office is implicitly proposing a modification to Owensby, the Patent Office has not satisfied the requirements set forth by the Federal Circuit. In sum, if the Patent Office is relying on a modified Owensby to teach the element, such reliance is improper.

In either event, it is not obvious that any address provided by Owensby is an internet protocol address, that such an address has unique content associated therewith, or that the address is associated with a different geographic location. Since Owensby does not teach any of these elements, and the Patent Office has not shown where these elements are in Heddaya, the combination of Owensby and Heddaya does not teach or suggest all the claim elements. Since the combination of Owensby and Heddaya does not teach or suggest all the claim elements, the Patent Office has not established obviousness, and the claims are allowable.

Several dependent claims deserve special mention.

Claims 41 and 49 recite "allowing access to the content when the mobile terminal uses the identified address." The Patent Office asserts that Owensby, col. 8, lines 40-60 and col. 6, lines 1-25, teach this element. Applicant respectfully traverses this assertion.

Owensby, col. 8, lines 40-60 states in full:

...Response Data in addition to the Wireless Mobile Location Data.

A preferred embodiment of a method according to the invention for providing a message to a subscriber of a wireless mobile communications service that is targeted to the subscriber on the basis of wireless mobile location includes at least the following steps. A first electronic database consisting of a plurality of pre-selected messages and predetermined criteria for choosing the messages to be provided to the subscriber is compiled. A wireless mobile terminal is then provided for initiating and receiving a wireless mobile communication comprising a call signal and Wireless Mobile Location Data included with the call signal. The call signal (if required) and the Wireless Mobile Location Data are then extracted from the wireless mobile communication and provided to a Call Management System including an Ad Chooser Server for choosing the messages to be provided to the subscriber. The predetermined criteria of the first database is then utilized to choose a message from the plurality of pre-selected messages of the first database that is targeted to the subscriber on the basis of the Wireless Mobile Location Data. Finally, the message that is targeted. . . .

While the passage describes the subscriber receiving messages/advertisements, there is no teaching or suggestion within the passage that the subscriber uses a received address to access content. In particular, the subscriber receives content without taking an affirmative step. Since the passage does not teach accessing content through the use of the identified address, as recited in the claim, the passage does not teach or suggest the element for which it is cited.

Owensby, col. 6, lines 1-25 states in full:

Further, the system and method of the invention permit the subscriber to interactively respond to a message provided to the subscriber, or to an inquiry for additional information from the operator of the service or from the sponsor of the message. Preferably, the operator queries the subscriber at the conclusion of a message, at the conclusion of a group of messages or at the conclusion of the wireless mobile communication, to select one of several options and then monitors the subscriber's response to the query. For example, the subscriber could request the operator to insert another message into the wireless mobile communication, to forward an audio, video or electronic data copy of the previously provided message to an electronic message input, storage and retrieval database (e.g., voice mail, e-mail, facsimile, etc.), or to establish a direct telecommunications or other data link with a representative of the sponsor of the message, such as a telemarketer. The subscriber may respond to the operator's query and the operator may fulfill the subscriber's request immediately following a particular message, immediately following a group of messages or following the conclusion of the wireless mobile communication (e.g., in the form of a "call-back" from a telemarketing representative).

While the passage indicates that the subscriber can request establishment of a direct telecommunications or other data link with a representative, this concept is not what is recited in the claim. The claim recites accessing the content through the address. The passage teaches connecting to a representative after listening to an advertisement/message. These are not the same things. In the passage, the subscriber has already received the content and then gets supplemental information from the representative, but the subscriber never uses any address to access the content, especially since the content has already been provided to the subscriber. As such, this passage does not teach or suggest the element for which it is cited.

Since the passages do not teach or suggest the element for which they are cited, Owensby does not teach or suggest the claim element. The Patent Office has thus failed to show where in the combination the element is taught or suggested. Since the Patent Office has failed to show where in the combination the element is taught or suggested, the Patent Office has not established obviousness, and claims 41 and 49 are allowable.

Claims 42 and 50 recite “delivering the content to the mobile terminal in response to a request from the mobile terminal using the identified address.” The Patent Office cites Owensby, col. 8, lines 40-60 and col. 6, lines 1-25. The cited passages are reproduced above. As explained above, the content is not delivered to the mobile terminal through the use of the identified address in the cited passages. That is, in one passage, the subscriber is connected to a representative. That is not, as explained above, delivery of the content to the mobile terminal. The other passage also does not show a request on the part of the subscriber to access the content through an address. The content is delivered independent of the subscriber’s request. Even if the subscriber makes a request, such a request is independent of an address, and is merely a generic request for advertisements (so as to subsidize the phone call). Neither passage teaches the recited claim element.

Since the passages do not teach or suggest the element for which they are cited, Owensby does not teach or suggest the claim element. The Patent Office has thus failed to show where in the combination the claim element is taught or suggested. Since the Patent Office has failed to show where in the combination the claim element is taught or suggested, the Patent Office has not established obviousness, and claims 42 and 50 are allowable.

Claims 43 and 51 recite “receiving a trigger initiated by an action of the mobile terminal as a condition of determining the current location of the mobile terminal.” The Patent Office cites Owensby, col. 8, lines 40-60 and col. 6, lines 1-25. Applicant traverses the assertion that these passages teach or suggest the claim element. While the user can request more information through a request to be connected to the representative, this is not a precondition for determining the current location of the mobile terminal. Nothing in the cited passages represents a trigger that is a precondition to determining the current location of the mobile terminal as recited in the claims.

Since the passages do not teach or suggest the element for which they are cited, Owensby does not teach or suggest the claim element. The Patent Office has thus failed to show where in the combination the claim element is taught or suggested. Since the Patent Office has failed to show where in the combination the claim element is taught or suggested, the Patent Office has not established obviousness, and claims 43 and 51 are allowable.

Claims 44, 45, 52, and 53 were rejected under 35 U.S.C. § 103 as being unpatentable over Owensby in view of Heddaya, and further in view of Guedalia. Applicant respectfully traverses. The standards for establishing obviousness are set forth above.

Applicant initially traverses the rejection of claims 44, 45, 52, and 53 because the base combination of Owensby and Heddaya is improper as explained above, and the base combination of Owensby and Heddaya does not establish obviousness for the underlying independent claims. The addition of Guedalia does not cure the deficiencies of the underlying combination and thus, the combination of the three references does not establish obviousness.

Applicant further traverses the rejection because the combination of Guedalia is not properly supported. Specifically, the Patent Office asserts that it would be obvious to include Guedalia into the combined teachings of Owensby and Heddaya "for the benefit of superior marketing and advertising in order to arrive at the invention as described in claims 44-45 and 52-53." (Office Action of April 26, 2005, p. 9, lines 7-9). This asserted motivation lacks the requisite evidentiary support required by the Federal Circuit. Since the motivation lacks the requisite evidentiary support, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection based on the combination is improper, and the Patent Office has not established obviousness. Applicant requests withdrawal of the § 103 rejection of claims 44, 45, 52, and 53 on this basis as well.

Applicant requests reconsideration of the rejections in light of the remarks presented herein. The combinations are not proper and do not establish obviousness. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

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